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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,438	10/20/2003	Kin-Chun Luk	21269US2	3374

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HOFFMANN-LA ROCHE INC.
PATENT LAW DEPARTMENT
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EXAMINER

MCKENZIE, THOMAS C

ART UNIT PAPER NUMBER

1624

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/689,438

Applicant(s)

LUK ET AL.

Examiner

Thomas McKenzie, Ph.D.

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-15 and 21 is/are allowed.
- 6) ☒ Claim(s) 1-10 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/4 2/4 2/4 4/4 6/4</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to an application filed on 10/20/04. There are twenty-one claims pending and twenty-one under consideration. Claims 1-15 and 21 are compound claims. Claim 16 is a composition claim. Claims 17-20 are method of using claims. This is the first action on the merits. The application concerns some 4-methyl-2-oxo-pyrimido[4,5-d]pyrimidine compounds, compositions, and uses thereof.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 16-20 are rejected under 35 U.S.C. 112, first paragraph, because the specification does not reasonably provide enablement for treating any human disease. The specification does not enable any physician skilled in the art of medicine, to make claims 17-20 or to use claim 16 of the invention commensurate in scope with these claims. The how to make requirement of the enablement statute, when applied to process claims, refers to operability and how to make the claimed process work. "The factors to be considered [in making an enablement rejection] have been summarized as the quantity of experimentation necessary, the amount of direction or guidance presented, the presence or absence of working

examples, the nature of the invention, the state of the prior art, the relative skill of those in that art, the predictability or unpredictability of the art and the breadth of the claims”, *In re Rainer*, 146 USPQ 218 (1965); *In re Colianni*, 195 USPQ 150, *Ex parte Formal*, 230 USPQ 546. The four main issues are the lack of any correlation between clinical efficacy for cancer treatment and Applicants' *in vitro* assay, the limited scope of compounds tested, the state of the prior art, and the breadth of the claims.

There is an *in vitro* assay, drawn to inhibition of the non-receptor tyrosine kinase Src, described in the passage spanning paragraph [0094], page 40 to paragraph [0092], page 44 with data on eight compounds. Applicants do not state and it is not recognized in the can therapy arts this assay is correlated to clinic efficacy for the treatment of any cancer. Laird (Expert Opin provides the state of the clinical arts in using Src inhibitors. Investig. Drugs), who states in the first complete paragraph, page 52 that the kinase inhibitors in clinical development "are almost exclusively [receptor tyrosine kinase]s, with the exception of Bcr-Abl. The assay used by Applicants is not for a receptor tyrosine kinase. Sawyer (Expert. Opin. Investig. Drugs, 2001) says on page 1338, section 6, "there are no Src inhibitor drugs on the market yet". In section 7, page 1339, she lists 3 tyrosine kinase inhibitors in the clinic. Two are inhibitors of a receptor tyrosine kinase and

the other of Bcr-Abl. The reason for this dearth of clinical candidates may lie in the diagram on page 1326, which shows Src involved in eight distinct signaling pathways. Src may be too ubiquitous to be safely inhibited. Sawyer (Expert. Opin. Investig. Drugs, 2004) in the paragraph spanning pages 11-13 describes a number of Src inhibitors but only PP1 and PP2 are described as active in some unnamed *in vivo* cancer model. The compounds PP1 and PP2 are structurally unrelated to those claimed by Applicants. Thus, 2 years after Applicants' effective filing date there was no art recognition of the therapeutic use of Src inhibitors.

The scope of the claims involves all of the thousands of compounds of claim 1 as well as the hundred of diseases embraced by the term cancer. Thus, the scope of claims is very broad.

MPEP §2164.01(a) states, "A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)." That conclusion is clearly justified here and undue experimentation will be required to practice Applicants' invention.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10 and 16-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 and 15-19 of copending Application No. 10/689,235. Although the conflicting claims are not identical, they are not patentably distinct from each other because except for the negative proviso at the end of claim 1 of the present application,

these claims use the same formula and are of the same scope. In the present case, removal of substituents from the anilino group would be obvious to the skilled medicinal chemist, attempting to simplify the active lead and to explore his SAR.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

4. Claims 11-15 and 21 are allowed.

Conclusion


5. Information regarding the status of an application should be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free). Please direct general inquiries to the receptionist whose telephone number is (703) 308-1235.

6. Please direct any inquiry concerning this communication or earlier communications from the Examiner to Thomas C McKenzie, Ph. D. whose telephone number is (571) 272-0670. The FAX number for amendments is (571)

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273-8300. The PTO presently encourages all applicants to communicate by FAX. The Examiner is available from 9:00am to 5:30pm, Monday through Friday. If attempts to reach the Examiner by telephone are unsuccessful, please contact James O. Wilson, acting SPE of Art Unit 1624, at (571)-272-0661.


Thomas C. McKenzie, Ph.D.
Primary Examiner
Art Unit 1624
(571) 272-0670